

PATENT  
Attorney Docket No. 2052.0485-00

**in the united states patent and trademark office**

**In re Application of:**

Mathias Alterman et al. ) Group Art Unit: 1626  
Application No.: 10/721,892 )  
Filed: November 26, 2003 ) Examiner: Laura Lynne Stockton  
For: Tricyclic Compounds Useful as ) Confirmation No.: 5982  
Angiotensin II Agonists )  
)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir.

## APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 1,017 days based on *Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). This application is being filed before or with the issue fee payment, as required by 37 C.F.R. § 1.705(b).

## I. Statement of the Facts Involved

#### A. Correct Patent Term Adjustment

Applicant received the Determination of Patent Term Adjustment with the Notice of Allowance and Fee(s) Due mailed from the Patent and Trademark Office (PTO) on June 8, 2009, advising that this application is entitled to 179 days of patent term adjustment.

Applicant has calculated a patent term adjustment of 1,017 days based on the following facts:

The above-identified application was filed November 26, 2003.

The first substantive Office action was mailed on March 17, 2006, resulting in a PTO delay of 415 days beyond the 14 months provided by 35 U.S.C. § 154(b). This first Office action was a Restriction Requirement.

Applicant filed a response to the Restriction Requirement on May 17, 2006, resulting in no reduction of patent term adjustment.

A second Office action was mailed July 26, 2006, resulting in no increase in patent term adjustment.

Applicant filed a response to the second Office action on December 26, 2006, resulting in a decrease in patent term adjustment of 61 days.

A third Office action was mailed March 12, 2007, resulting in no increase in patent term adjustment.

Applicant filed a response to the third Office action on May 14, 2007, resulting in no reduction of patent term adjustment.

A fourth Office action was mailed May 25, 2007, resulting in no increase in patent term adjustment.

Applicant filed a response to the fourth Office action on August 27, 2007, resulting in a decrease in patent term adjustment of 2 days. Applicant filed a subsequent response to the fourth Office action on December 17, 2007, resulting in an additional decrease in patent term adjustment of 112 days.

A fifth Office action was mailed March 14, 2008, resulting in no increase in patent term adjustment.

Applicant filed a Notice of Appeal on August 14, 2008, resulting in a decrease in patent term adjustment of 61 days.

Applicant filed a Request for Continued Examination on March 13, 2009, resulting in no reduction of patent term adjustment.

Under *Wyeth v. Dudas*, the period of patent term extension under 35 U.S.C. § 154(b)(1)(B) begins to toll three years after the application was filed, i.e., three years from November 26, 2003. Thus, the period of patent term extension under 35 U.S.C. § 154(b)(1)(B) began to toll on November 26, 2006, and stopped on March 13, 2009, with the filing of an RCE, resulting in 838 days (2008 being a leap year) of patent term extension under the 3-year pendency rule. The initial PTO delay occurred on March 17, 2006, which, according to *Wyeth v. Dudas*, does not overlap the period of patent term extension under 35 U.S.C. § 154(b)(1)(B). *Wyeth v. Dudas* instructs that the PTO delay of 415 days should be counted in addition to the subsequent 838 days of PTO delay under the 3-year pendency rule.

Thus, the total of PTO adjustments based on delay is 1,253 days (415 days + 838 days) and the total of reductions in term adjustment is 236 days (61 days + 2 days + 112 days + 61 days), resulting in a patent term adjustment of 1,017 days total. Applicant respectfully requests that the current patent term adjustment be reconsidered.

#### **B. Terminal Disclaimer**

The above-identified application is not subject to a Terminal Disclaimer.

#### **C. Reasonable Efforts**

There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704, other than those discussed above.

**II. Fee**

As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a fee of \$200.00. Applicants request that this \$200.00 fee and any other fees due in connection with the filing of this application be charged to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 3, 2009

By: 

Maryann T. Puglielli  
Reg. No. 52,138  
(202) 408-6054